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EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 05/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,976

Applicant(s)

I'ANSON ET AL.

Examiner

Yogesh C Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 28 3/4 4
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Pre-amendment, paper # 5, received on 6/27/2003, is acknowledged and entered.
Claims 1-18 are cancelled and new claims 18-56 have been added. Currently claims 18-56 are pending for examination.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 18-22, 24-44, and 46-56 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

2.1. Claimed Invention(s) does not fall within the Technological Art.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the

Art Unit: 3625

term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, **State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).**

In the present application, Claims 18-22, 24-44, and 46-56 do not appear to have

Art Unit: 3625

connection to the technological arts. None of the steps, system or article of manufacture indicate a connection to a computer or technology. The steps of storing data, determining when a party is close to a location, etc. could be performed manually by people. Therefore, the claims are directed towards non-statutory subject matter. Claims 20-21 and 42-43 do mention the use of a location server only as an alternative, thereby implying that determination can also be done alternatively by other means, such as manual means. Claim 40 and thereafter its dependent claims 41-56 do recite the use of a program storage device, readable by machine only in the preamble but not in the body of claims. The recitation of a technological device has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

To overcome this rejection the Examiner recommends that Applicant amend the claims to better clarify that the steps are being performed within the technological arts, such as incorporating/integrating a computer/software/hardware computer network or electronic network functionally with manipulative steps recited in the claims.

3.1 The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 3625

Claims 18-56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The independent claim(s) 18, 35 and 40 contain subject matter, "determining when the first party is close to said identified location , and checking said stored second data to ascertain whether or not the transaction has reached a predetermined status appropriate for said future visit to be effected.", which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This limitation does not indicate the use of technology whereas the specification explicitly teaches that the step of "determining when the first party is close to said identified location , and checking effected" is executed by a computerized service system via Internet/WAP . Since claims 19-34, 36-39, and 41-56 are dependencies of these independent claims they also inherit the same deficiency.

3.2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention and as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01.

The independent claim(s) 18, 35 and 40 contain subject matter, "determining when the first party is close to said identified location, and checking said stored second data to ascertain whether or not the transaction has reached a predetermined status appropriate for said future visit to be effected". From the body of the claim It is not clear if this step is executed by technological arts as shown in the disclosure. The omitted elements, as per the applicant's

Art Unit: 3625

specification, are the use of a computerized service system via Internet/WAP for the determining step. Since claims 19-34, 36-39, and 41-56 are dependencies of these independent claims they also inherit the same deficiency.

Claims 21-22 and 42-43 state that the method according to claim 18, wherein said first data is stored by the first party or second party in a third-party service system the location of the first party being provided to the third-party service system for effecting the determination in step (c) by either the first party or by a location server. As per this recitation, the third party service system effects the determination in step (c) and there is insufficient antecedent basis for this limitation in the claim.

Claims 32-33 and 54-55 state "wherein the second party is given no indication of the location of the first party by the third-party service system except to the extent that a **said match** is indicated to the second party". There is insufficient antecedent basis for the limitation, " **said match**" in the claims 32-33 and 54-55.

4. Note: Citations from references: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 102

5. (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 18-28, 31, 34-38, 40-50, 53 and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by Treyz et al. (US Patent 6,587,835 B1); hereinafter, referred to as Treyz.

Regarding claim 18, Treyz discloses a notification method concerning a transaction being effected between a mobile first party and a second party having associated premises (see at least col.41, line52-col.46, line 34. See also col.58, line 61-col.66, line 34.), the method comprising:

- (a) storing first data as to a future visit of the first party to the premises and identifying the parties and location of the premises;
- (b) storing, independently of the first party, second data indicative of the current status of the transaction, said second data being updated by the second party

(For (a) and (b) see at least col.42, lines 46-65 "..... *Illustrative steps involved in sending notification messages to handheld computing devices in a mall or other such establishment are shown in FIG. 63. At step 638, the user is allowed to request a notification from the merchant. If the user requests notification, a computer at the merchant or the like may send the notification to handheld computing equipment 12 over a local or remote wireless link at step 640. Notifications may be sent when clothes are ready at the cleaner, when the user's car is ready (e.g., if the oil was being changed), when prepared-to-order food is ready, when film is ready to be picked up, etc. Such notifications may be sent automatically by tying the transmission of the notifications to the state of certain equipment at the merchant.* " . Note: The data about clothes, user's car, prepared to order food, etc. corresponds to the first data stored in the merchant's computer against the user's order for

Art Unit: 3625

which the user will have to make a future visit to pick up the car, clothes, and food. The merchant's computer stores the second data corresponding to the readiness of the ordered items, independently of the of the first party, and this second data is the updated data indicating the readiness of the order. See also col.58, line 61-col.66, line 34.); and

(c) determining when the first party is close to said identified location (see at least col.23, lines 37-56, "*..If desired, the location of handheld computing device 12 and therefore the user may be determined using global positioning system (GPS) satellites, as shown in FIG. 18.....*" , and checking said stored second data to ascertain whether or not the transaction has reached a predetermined status appropriate for said future visit to be effected (see at least col. 42, line 29-col.43, line 45, "*Such notifications may be sent automatically by tying the transmission of the notifications to the state of certain equipment at the merchant. For example, a photo processor may electronically indicate when it is finished processing the user's film. At the cleaners, an order may be processed using an electronic tracking system. A notification may be sent to the user when the tracking system indicates that the user's clothes are ready. These are merely illustrative examples. Notifications may be sent to the user based on any suitable criteria.*" . Treyz discloses that checking is done if the ordered product/services is ready for delivery because after that only the notification is sent to the user. Also the tracking system would inherently have data stored about the status of readiness of order and then only it can electronically tie with the transmission of electronic notifications to the user. See also col.58, line 61-col.66, line 34.).

Regarding claim19, Treyz discloses that the method according to claim 18, further comprising notifying the first party that making the visit is appropriate in response to a determination in step (c) that making the visit is appropriate (see at least col. 42, line 29-col.43,

Art Unit: 3625

line 45, " *Such notifications may be sent automatically by tying the transmission of the notifications to the state of certain equipment at the merchant. For example, a photo processor may electronically indicate when it is finished processing the user's film. At the cleaners, an order may be processed using an electronic tracking system. A notification may be sent to the user when the tracking system indicates that the user's clothes are ready. These are merely illustrative examples. Notifications may be sent to the user based on any suitable criteria.* " . Note:

Here, Treyz discloses that user is notified to make the visit for picking up the ordered item, which satisfies the claimed limitation. See also col.58, line 61-col.66, line 34.).

Regarding claims 20 & 21, The method according to claim 18, wherein said first data is stored by the first party or second party in a third-party service system (see at least col.14, lines 24-41, which discloses that the said first data can be stored at a service provider server corresponding to the claimed third- party service system), the location of the first party being provided to the third-party service system for effecting the determination in step (c) by either the first party or by a location server (see at least col.2, line 66-col.3, line 9 which discloses that the location of the hand held computing device belonging to the first party can be tracked on proximity basis , and notified of special messages for certain events like pick ups of completed orders, etc.. See also col.19, lines 22-53 ([discloses transaction information on a remote server] and col.58, line 61-col.66, line 34.) .

Regarding claim 22, Treyz shows that the method according to claim 18, wherein said first data is stored by the first party in a mobile entity of the first party, the mobile entity providing the location of the first party for the determination carried out in step (c) (See at least col.19, lines 22-53, " *When handheld computing device 12 is used in wireless financial transactions, handheld computing device 12 may retain information on each of the financial transactions. If*

Art Unit: 3625

desired, this financial information may be retained on a remote server or the like. Handheld computing device 12 may also display on-screen options such as options 168 and 170 that allow the user to save the financial transaction information (e.g., information on the \$156.07 purchase in the example of FIG. 11) to either an expense report application or a financial planning application.". ".See also col.58, line 61-col.66, line 34.).

Regarding claim 23, Treyz discloses that the method according to claim 18, wherein said first data is stored by the first party in a mobile entity of the first party, the mobile entity receiving short-range wireless signals from the premises of the second party, the receipt of said signals being used in the determination carried out in step (c) to indicate that the first party is near the location of the premises (see at least col.23, lines 36-56, "*If desired, the location of handheld computing device 12 and therefore the user may be determined using global positioning system (GPS) satellites, as shown in FIG. 18. Handheld computing device 12 may receive satellite signals from GPS satellites 246. By analyzing these signals with GPS receiver 248, handheld computing device 12 can determine the location of the user.*"

Regarding claim 24, Treyz discloses that the method according to claim 18, wherein said second data is stored in a status database maintained by the second party, the status check of step (c) being effected by accessing the status database ((see at least col. 42, line 29-col.43, line 45, "*Such notifications may be sent automatically by tying the transmission of the notifications to the state of certain equipment at the merchant. For example, a photo processor may electronically indicate when it is finished processing the user's film. At the cleaners, an order may be processed using an electronic tracking system. A notification may be sent to the user when the tracking system indicates that the user's clothes are ready. These are merely illustrative examples. Notifications may be sent to the user based on any suitable criteria.*" . Treyz discloses that checking is done if

Art Unit: 3625

the ordered product/services is ready for delivery because after that only the notification is sent to the user. Also the tracking system would inherently have data stored about the status of readiness of order and then only it can electronically tie with the transmission of electronic notifications to the user. See also col.58, line 61-col.66, line 34.)

Regarding claim 25, Treyz discloses that the method according to claim 20, wherein said second data is provided by the second party to the third-party service system and stored therein, the status check of step (c) being effected by accessing said second data stored by the third-party service system (see at least col. 42, line 29-col.43, line 45, " *Such notifications may be sent automatically by tying the transmission of the notifications to the state of certain equipment at the merchant. For example, a photo processor may electronically indicate when it is finished processing the user's film. At the cleaners, an order may be processed using an electronic tracking system. A notification may be sent to the user when the tracking system indicates that the user's clothes are ready. These are merely illustrative examples. Notifications may be sent to the user based on any suitable criteria.* " . Treyz discloses that checking is done if the ordered product/services is ready for delivery because after that only the notification is sent to the user. Also the tracking system would inherently have data stored about the status of readiness of order and then only it can electronically tie with the transmission of electronic notifications to the user. See also col.58, line 61-col.66, line 34.).

Regarding claim 26, Treyz discloses that the method according to claim 19, wherein the result of the status check of step (c) is reported to the first party whether or not said predetermined status has been reached (see at least col.2, line 66-col.3, line 15, " *The shopping assistance service may display information on specials. The user may search for desired products, services, and stores at the mall. Various types of messages may be provided to the handheld computing*

Art Unit: 3625

device. For example, a proximity message may be provided. The user may be alerted when a message is received from a nearby merchant. The user may also be alerted to the availability of a special. Messages regarding specials may include interactive features. Messages may be provided to the user to notify the user or to remind the user of certain events. The user may adjust alert settings for various message types. ". Here, Treyz discloses that all types of messages and alerts can be communicated to the user's hand held device , which implies that these messages may relay notifications not related to the predetermined status as claimed in the application. See also col.58, line 61-col.66, line 34.).

Regarding claim 27, Treyz shows that the method according to claim 18, wherein said predetermined status corresponds to the availability for collection at the premises of an item that is a subject of said transaction (see at least col. 42, line 29-col.43, line 45, " *Such notifications may be sent automatically by tying the transmission of the notifications to the state of certain equipment at the merchant. For example, a photo processor may electronically indicate when it is finished processing the user's film. At the cleaners, an order may be processed using an electronic tracking system. A notification may be sent to the user when the tracking system indicates that the user's clothes are ready. These are merely illustrative examples. Notifications may be sent to the user based on any suitable criteria.* " . Treyz discloses that checking is done if the ordered product/services is ready for delivery because after that only the notification is sent to the user. Also the tracking system would inherently have data stored about the status of readiness of order and then only it can electronically tie with the transmission of electronic notifications to the user. See also col.58, line 61-col.66, line 34.).

Regarding claim 28, Treyz discloses that the method according to claim 19, wherein said predetermined status corresponds to the availability for collection at the premises of an item that

Art Unit: 3625

is a subject of said transaction and wherein the first party is only notified if said status check indicates that the item is available for collection (see at least col. 42, line 29-col.43, line 45, "*Such notifications may be sent automatically by tying the transmission of the notifications to the state of certain equipment at the merchant. For example, a photo processor may electronically indicate when it is finished processing the user's film. At the cleaners, an order may be processed using an electronic tracking system. A notification may be sent to the user when the tracking system indicates that the user's clothes are ready. These are merely illustrative examples. Notifications may be sent to the user based on any suitable criteria.*" . Treyz discloses that checking is done if the ordered product/services is ready for delivery because after that only the notification is sent to the user. Also the tracking system would inherently have data stored about the status of readiness of order and then only it can electronically tie with the transmission of electronic notifications to the user. See also col.58, line 61-col.66, line 34.).

Regarding claim 31, Treyz discloses that the method according to claim 20, wherein the location of the first party is only provided to the third-party service system upon the first party indicating that any match is to be identified (see at least col.2, line 46-col.3, line 15, "*The handheld computing device may display price information.....The user may be alerted when a shopping assistance service is available.....The shopping assistance service may display information on specials. The user may search for desired products, services, and stores at the mall. Various types of messages may be provided to the handheld computing device. For example, a proximity message may be provided. The user may be alerted when a message is received from a nearby merchant. The user may also be alerted to the availability of a special. Messages regarding specials may include interactive features. Messages may be provided to the user to notify the user or to remind the user of certain events. The user may adjust alert settings for various message types.*" . Here, Treyz discloses that all types of messages and alerts can be communicated to the user's hand held device only when the

Art Unit: 3625

proximity of his hand held device is detected or matched . See also col.58, line 61-col.66, line 34.).

Regarding claim 34, Treyz discloses that the method according to claim 18, wherein step (a) is effected by the second party during an initial visit of the first party to said premises to instigate said transaction see at least col.42, lines 46-65 "*..... Illustrative steps involved in sending notification messages to handheld computing devices in a mall or other such establishment are shown in FIG. 63. At step 638, the user is allowed to request a notification from the merchant. If the user requests notification, a computer at the merchant or the like may send the notification to handheld computing equipment 12 over a local or remote wireless link at step 640. Notifications may be sent when clothes are ready at the cleaner, when the user's car is ready (e.g., if the oil was being changed), when prepared-to-order food is ready, when film is ready to be picked up, etc. Such notifications may be sent automatically by tying the transmission of the notifications to the state of certain equipment at the merchant.*" . Note: The data about clothes, user's car, prepared to order food, etc. corresponds to the first data stored in the merchant's computer against the user's order The merchant's computer stores the second data corresponding to the readiness of the ordered items, independently of the of the first party, and this second data is the updated data indicating the readiness of the order. In order to place orders the user has to provide data to the merchant and that can be done either he visits the party in person or online initially. See also col.58, line 61-col.66, line 34.) .

Regarding claims, 35-38 and 40-50, 53 and 56, their limitations are closely parallel to the claims 18-28, 31, and 34 and are therefore analyzed and rejected on the basis of same rationale.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29-30, 32-33, 39, 51-52, and 54-55 are rejected under 35 U.S.C. 103(a) as being obvious over and further in view of Official Notice.

Regarding claim 29, Treyz discloses notification method concerning a transaction being effected between a mobile first party and a second party, having associated premises as analyzed and discussed in claim 19 above. Treyz further discloses that the method according to claim 19, wherein said predetermined status corresponds to the availability for collection at the premises of an item that is a subject of said transaction and wherein said first data includes date data specifying an expected date when the item will be available for collection, and wherein step (c) further comprises checking whether or not the item is ready and notifying the first party of such circumstances (see at least col. 42, line 29-col.43, line 45, " *Such notifications may be sent automatically by tying the transmission of the notifications to the state of certain equipment at the merchant. For example, a photo processor may electronically indicate when it is finished processing the user's film. At the cleaners, an order may be processed using an electronic tracking system. A notification may be sent to the user when the tracking system indicates that the user's clothes are ready. These are merely illustrative examples. Notifications may be sent to the user based on any suitable criteria.* " . Treyz discloses that checking is done if the ordered product/services is ready for

Art Unit: 3625

delivery because after that only the notification is sent to the user. Also the tracking system would inherently have data stored about the status of readiness of order and then only it can electronically tie with the transmission of electronic notifications to the user. See also col.58, line 61-col.66, line 34.). Treyz does not disclose during the step of checking that if the item is overdue and not available for collection and notifying the first party of such circumstances. The examiner takes the Official Notice of both the notoriously old and well-know concept and benefits in the field of retail selling to check if the ordered item is overdue and not available for collection and notifying the first party of such circumstances. For, example if the furniture store or an appliance store finds that the ordered furniture/appliance is overdue and not available for collection they always notify the customer of such circumstances to avoid him an unnecessary trip and disappointment as a part of good customer service. In view of the Official Notice, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Treyz to incorporate the feature of Official Notice to check if the ordered item is overdue and not available for collection and notifying the first party of such circumstances because it will help the merchants to avoid embarrassment and criticism from the customers for not informing him in time to avoid an unnecessary trip and disappointment as exemplified above.

Regarding claim 30, Treyz discloses a notification method concerning a transaction being effected between a mobile first party and a second party, having associated premises as analyzed and discussed in claim 19 above. Treyz further discloses that method according to claim 19, wherein said predetermined status corresponds to the availability for collection at the premises of an item that is a subject of said transaction and wherein the first party is notified that said item is available for collection, (see at least col. 42, line 29-col.43, line 45, " *Such*

Art Unit: 3625

notifications may be sent automatically by tying the transmission of the notifications to the state of certain equipment at the merchant. For example, a photo processor may electronically indicate when it is finished processing the user's film. At the cleaners, an order may be processed using an electronic tracking system. A notification may be sent to the user when the tracking system indicates that the user's clothes are ready. These are merely illustrative examples. Notifications may be sent to the user based on any suitable criteria. " . Treyz discloses that checking is done if the ordered product/services is ready for delivery because after that only the notification is sent to the user. Also the tracking system would inherently have data stored about the status of readiness of order and then only it can electronically tie with the transmission of electronic notifications to the user. See also col.56, line 61-col.66, line 34.).

Treyz does not disclose that the first party, on being notified of the readiness of the item to be collected notifies the second party of a planned collection time. The examiner takes the Official Notice of both the notoriously old and well-know concept and benefits, in the field of retail selling and buying, of informing a second party of a planned collection time. It is well known that when a customer places an order either for home delivery or pick up, for example furniture or glasses, then he, as a first party, when informed of the readiness of the order, confirms his acceptance for home delivery or for pick up of the ordered item at an approximate date and time as per his convenience. In view of the Official Notice, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Treyz to incorporate the feature of Official Notice that the first party as a buyer notifies the second party the merchant or a third party of a planned collection time because it will help the merchants to schedule the pick up without any ambiguity.

Regarding claims 32-33, Treyz discloses a notification method concerning a transaction being effected between a mobile first party and a second party, having associated premises and

Art Unit: 3625

also storing data in a third party system as analyzed and discussed in claims 20-21. Treyz further discloses that the second party is given no indication of the location of the first party by the third-party service system (see at least col.30 lines 2-22 which teaches providing services to the user through a remote service provider server and this service provider can detect the location of the user by detecting the location of the hand held computing device when it is in the proximity of a particular mall, merchant, store that is the premises, see col.38, lines 23-65 to inform him about a particular event such as a special sale, advertisement, pick-up of an item, movie, etc. without giving any indication of the location to the second party, that is the merchant.). Treyz does not disclose informing/notifying the second party that a said match meaning the desired user has been spotted and notified of a message about an event. The examiner takes an Official Notice about the notoriously well-known concept and benefits of notifying the manufacturer/advertiser/merchant/ by the service provider about conveying of the advertisements or messages meant to be conveyed to the consumers on their behalf by the users for their information and satisfaction as per the contractual terms between manufacturer/advertiser/merchant/ and the service provider. In view of the Official Notice, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Treyz to incorporate the feature of Official Notice of informing/notifying the second party that a said match meaning the desired user has been spotted and notified of a message about an event because it will help the merchants/advertisers to know that the service provider has taken the necessary action as per the contractual terms as exemplified above.

Regarding claims, 39, 51-52 and 54-55, their limitations are closely parallel to the claims 29-30 and 32-33 and are therefore analyzed and rejected on the basis of same rationale.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Publication NO: 2001/0018660 A1 to Sehr discloses systems and methods for facilitating via a mobile entity a plurality of services such as purchases of goods and services, detecting location of the mobile entity and more (see at least paragraph 0024 on page 2 and paragraph 0131 on pages 18-19).

(ii) Press release, " Signalsoft: Signalsoft and diAX launch first location-based information service in Europe"; M2 Presswire; Coventry; Jan 18, 2000; pg.1; extracted on Internet from prquest.umi.com database on 5/11/2004 discloses delivering real time information to mobile users when they are detected in the proximity of a location.

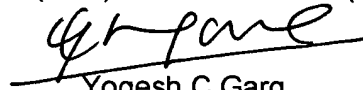
(iii) WO 00/05825 to Rayne discloses a method of and apparatus for connecting calls to mobile stations (A to H) in a radio telecommunications network, such as a private mobile radio system or a cellular telephone system (see at least abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3625

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Yogesh C Garg
Examiner
Art Unit 3625

YCG
May 11, 2004